

REMARKS**Status of Claims**

Prior to further examination, applicants respectfully request consideration based on the amendments and remarks made in this Submission. The Office Action mailed December 28, 2004 has been further reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-39 were pending in the application. Claims 1, 14, 15, 18, 21, 23, 29-31, 37, and 39 have been amended, claims 16-17 have been cancelled without prejudice or disclaimer and no new claims have been added. Therefore, claims 1-15 and 18-39 are pending in the application and are submitted for reconsideration.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-22 and 24-38 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Even though applicants do not agree with this rejection, applicants have amended the claims to recite word data indexes instead of the more generic semantic data indexes (even though the semantic data connotes word data or data with meaning). The use of word data indexes together with the use of key words for retrieving data from such indexes is disclosed at several places in the originally filed application. For example, page 1, lines 15-20 describes the use of words and items as indexes which can serve as direct access points to individual files to which they refer. Page 7, lines 18-36 describes the indexing process and teaches the analysis of textual information (which is a collection of words) as part of the indexing process.

Originally filed claims 11 and 39 (which are of course a part of the original disclosure; See MPEP 2163.06) disclose searching the claimed indexes by using *key words or indexes* which makes clear key words were indexes in at least certain embodiments of the invention (which are now claimed in all the pending claims). The same originally filed claim 39 (as well as several other portions of the specification) also makes clear that the itemized indexes

(containing key words as made clear in the search request) are *derived during* the scanning operation. Therefore, the originally filed disclosure (which includes the originally filed claim 39) clearly discloses that the scanning step of the backup operation is used to derive a set of itemized indexes which are searchable by key words. Therefore, each claimed limitation is disclosed in the originally filed specification.

Furthermore, the use of key words to search the claimed indexes in the originally filed claims 11 and 39 establish that the applicants had possession of the claimed subject matter when the original application was filed. Accordingly, applicants submit that pending claims meet the requirements of 35 U.S.C. § 112, first paragraph, and this applied rejection should be withdrawn.

Prior Art Rejections

In the Office Action, claims 23-28 and 39 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,778,395 to Whiting et al. (hereafter “Whiting”). Claims 1-22 and 29-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whiting in view of U.S. patent 6,278,992 to Curtis et al. (hereafter “Curtis”). Applicants respectfully traverse these rejections for at least the following reasons.

Each of the independent claims 1, 14, 15, 18, 21, 23, 29, 31, 37, and 39 recite, *inter alia*, a process (or corresponding system/software) that (1) uses the scanning step of a backup operation on files to substantially simultaneously derive a set of word data indexes, (2) whereby the word data indexes provide a direct access to the files based on the word data content of the files. These recited features are not disclosed or suggested by the applied prior art.

Specifically, with respect to the Whiting reference, applicants note that the Office Action acknowledges that Whiting does not disclose the creation of word (or semantic) data indexes as a part of the backup process. As noted earlier, the only indexing disclosed in Whiting is directed to properly performing the backup process in order to keep track of the files for the backup system. See col. 17, line 5 to col. 18, line 35 of Whiting. As noted in the Abstract, Whiting states that all its enhancement *significantly reduce both the amount of storage and the amount of network bandwidth for performing the backup*. See lines 14-16 of

the Abstract of Whiting. Therefore, Whiting teaches indexing during a backup process for improving the efficiency of the backup process itself and does not teach the claimed using of the scanning step of a backup to substantially simultaneously derive a set of word data indexes which allow direct access (by a key word based search request) to the files based on the word data content of the files.

In order to cure this deficiency of Whiting, the Office Action relies on Curtis. However, even this combination (if permissible, which it is not) does not disclose or suggest the claimed feature of creating a word data index as a part of the backup process. Curtis simply discloses a technique for improved storage and retrieval of data (typically stored in computer databases) for a search engine but does not relate any way to the backup process (and indexing related thereto). Therefore, even the combination of Whiting and Curtis does not disclose the features recited in the pending independent claims.

In this context, the Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966). Clearly, at best the applied references are silent on the claimed feature that requires deriving a set of word data indexes as part of a backup process and this disclosure does not meet the required burden to allege obviousness.

Furthermore, there is no motivation to combine the references in the manner suggested in the Office Action. The Office Action states generically that the high speed indexing and retrieval for searching purposes taught by Curtis would motivate the combination. Of course, this is exactly the opposite of the teaching of Whiting which seeks to optimize the efficiency of the backup process and adding the indexing and searching of Curtis to the backup process of Whiting achieves the opposite result to that desired by Whiting. In other words, there is simply no motivation or teaching to combine the references as suggested by the Office Action since it would result in altering the principle of operation of

Whiting (or at the very least defeat its stated purposes). Therefore, applicants submit there is no motivation to combine the references in the manner proposed other than the impermissible use of the applicants' own teaching.

Therefore, applicants submit that the applied prior art does not disclose the features recited in the pending independent claims. Furthermore, there is no motivation to combine the references in the manner proposed in the Office Action and in fact Whiting actually teaches away from the combination. Accordingly, applicants submit that the pending independent claims are patentable over the applied prior art.

The dependent claims are also patentable for at least the same reasons as the respective independent claims on which they ultimately depend. In addition, they recite additional patentable subject matter when considered as a whole.

Conclusion

In view of the above amendments and remarks, applicants believe that the application is now in condition for allowance. An indication of the same is respectfully requested. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Respectfully submitted,

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